



Attorney Docket No. P60448US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of FORSSMANN et al.

Application No.: 10/760,557

Group Art Unit: 1646

Filed: January 21, 2004

Examiner: Mertz, Prema Maria

For HUMAN CIRCULATING CYTOKINE CC-1

**RESPONSE  
TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

Sir:

This paper responds to the Office Action (restriction requirement) mailed February 16, 2006.

Pursuant to the restriction requirement under 35 USC 121, election is made, hereby, to prosecute invention Group I, claims 9, 13, 16, and 17, and selecting SEQ ID NO: 6, with traverse. Traverse is maintained in connection with the requirement "to select one polypeptide."

Traverse is maintained, first of all, because the PTO has failed to meet the requirements for restriction among the amino acid sequences SEQ ID NO: 6 and modified SEQ ID NO: 6, as recited in the elected claims. In order to make a restriction "Proper," PTO "Examiners must provide reasons and/or examples to support conclusions." MPEP 803(II) (emphasis added). Since the examiner failed to provide the necessary reasons and/or examples to support the requirement to select one polypeptide, the requirement is improper, on its face. MPEP 803(II).

Furthermore, the requirement to select a single polypeptide, and withdrawal of all non-selected peptides, is an improper attempt to divide a proper Markush group and, so, would violate

applicants' right "to have each claim examined." *In re Weber*, 198 USPQ 328, 331 (CCPA 1978).  
*In re Haas ("Haas I")* 179 USPQ 623 (CCPA 1973). In accordance with MPEP 803.02,  
"Restriction—Markush Claims":

PRACTICE RE MARKUSH-TYPE CLAIMS . . .

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

All of the amino acid sequences falling within the scope of the recited Markush grouping in the claim share a substantial structural feature, i.e., the basic sequence of amino acid residues found in SEQ ID NO: 6; differences among the Markush grouping of sequences are reflected in the moieties bound to the individual amino acid residues.

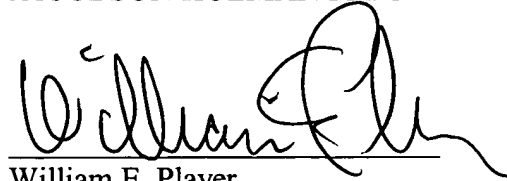
Since the SEQ ID NO: 6 and the modified SEQ ID NO: 6 sequences all share utility and a structural feature essential to the utility, the non-selected peptide sequences cannot be withdrawn from consideration, allegations to the contrary set forth in the restriction statement, notwithstanding.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By:

A handwritten signature in black ink, appearing to read "William E. Player", written over a horizontal line.

William E. Player

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